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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MUSTANSIR BANATWALA, STEPHEN J. FOLEY and
ALEXANDER KORDUN

Appeal 2009-006785
Application 10/736,293¹
Technology Center 2400

Before JAY P. LUCAS, CAROLYN D. THOMAS, and
DEBRA K. STEPHENS, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL²

¹ Application filed December 16, 2003. The real party in interest is International Business Machines Corporation.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1, 2 and 4-13, which are all the claims remaining in the application, as claim 3 is cancelled. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

The present invention relates to managing external data sources in a discussion forum.

Claim 1 is illustrative:

1. A discussion forum resource comprising:
 - at least one topic thread disposed in the discussion forum resource forum and created for externally sourced content in the discussion forum resource [sic], wherein said externally sourced content comprise postings from another forum resource; and,
 - a data aggregator executing in a computing platform and coupled to said at least one topic thread and configured to manage said externally sourced content in said at least one topic thread.

Appellants appeal the following rejections:

1. Claims 1, 2, and 4-13 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement;
2. Claims 1, 2, and 4-13 under 35 U.S.C. § 101 because the claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 U.S.C. 101; and
3. Claims 1, 2, and 4-13 under 35 U.S.C. § 102(e) as anticipated by Fredell (Patent Appl. Pub. No. US 2001/0028364 A1, Oct. 11, 2001).

FACTUAL FINDINGS

1. Fredell discloses that “[t]he method allows for posting over the global communications network to selected project participants the plurality of project tasks. The posted plurality of project tasks is linkable to the database to retrieve project documentation that requires review by the selected project participants.” (¶ [0010].)

2. Fredell discloses that “[i]con 105 provides access to a web page that enables on-line, not necessarily real-time, discussions regarding issues that may develop during the project.” (¶ [0096].)

3. In Fredell, “the present invention enables project participants to have an on-line forum that allows them to post issues or respond to issues posted by other participants.” (¶ [0097].)

ANALYSIS

§112, first paragraph Rejection

Issue1: Did the Examiner err in finding that the claimed “computing platform” is subject matter that was not described in the original specification?

The Examiner found that “the ‘computing platform’ does not appear anywhere within the original specification.” (Ans. 3.)

Appellants contend that “it is plain to see from Figure 1 that a computing platform is present in the form of the collaborative host 130.” (App. Br. 7.) We agree with Appellants.

In order to satisfy the written description requirement, “the [original] specification must describe an invention understandable to that skilled

artisan and show that invention actually invented by the invention claimed.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010)(en banc). “[T]he test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Id.* (citations omitted). One shows possession “by such descriptive means as words, structure, figures, diagrams, formulas, etc. that fully set forth the claimed invention.” *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

Here, Appellants have directed our attention to a diagram in the original specification, e.g., element 130 in Figure 1, which illustrates a *collaborative host*. The Examiner has not shown how such a “collaborative host” is distinguishable from the claimed “computing platform.” We find that one skilled in the art at the time of the invention would view the diagram of the collaborative host as including some type of computing means. Therefore, Appellants’ evidence is sufficient to show that Appellants had possession of the claimed subject matter, i.e., computing platform, as of the filing date.

Based on the record before us, we find that the Examiner did err in rejecting claims 1, 2, and 4-13 under 35 U.S.C. § 112, first paragraph. Accordingly, we reverse the rejection of claims 1, 2, and 4-13 under 35 U.S.C. § 112, first paragraph.

§101 Rejection

Issue2: Did the Examiner err in finding that the claims are non-statutory?

Appellants contend “that postings relating to externally sourced data can be posted in another[] externally disposed discussion forum so as to perform the requisite transformation.” (App. Br. 7; *see also* Reply Br. 3.)

The Examiner found that claim 1 includes “a topic thread and a data aggregator, all of which are interpreted as being software[,] hence lacking a hardware component. . . . therefore the claims fail in possessing a physical component to constitute a machine or a manufacture rendering them non-statutory under [35] U.S.C. § 101.” (Ans. 9-10.)

In settling this issue, the machine-or-transformation test is a useful and important clue, an investigative tool, for determining whether some claimed inventions are processes under §101. *See Bilski v. Kappos*, 130 S.Ct. 3218, 3227 (1020). “The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transform an article.” *In re Bilski*, 545 F.3d 943, 961-62 (Fed. Cir 2008)(en banc).

Here, the Examiner found that claim 1 is not limited to a particular machine (Ans. 9). We see no clear indication that Appellants are disputing this finding. However, we add that while independent claim 1 recites a “computing platform” and independent claim 13 recites “a computer platform,” we find that such recitations suggests at best a nominal use of a general purpose computer. See *Gottschalk v. Benson*, 409 U.S. 63, 72 (1972): “The general purpose computer is designed to perform operations under many different programs.” A nominal recitation of a general purpose computer is not an expressed recitation to a *particular* machine. Thus, we

do *not* find that claims 1 and 13 are tied to a particular machine. Claim 5 mentions no machine, nominal or not, at all. Accordingly, we find that Appellants have *not* shown that the Examiner erred in finding that independent claims 1, 5, and 13 fail to meet the machine prong of the machine-or-transformation test.

As for the transformation prong of the test, Appellants contend that the claims perform a transformation (App. Br. 7.) We disagree.

For instance, claim 1 merely requires posting content from one forum resource to another discussion forum resource (i.e., copies data from one place to another) (*see* Claim 1). However, this is not a transformation of an article from one state to another as the data does not transform into another state, merely the data is placed in multiple locations.

Thus, we do not find that the claims perform a transformation as contemplated by current law. Accordingly, we find that Appellants also have *not* shown that the Examiner erred in finding that claims 1, 5, and 13 fail to meet the transformation prong of the machine-or-transformation test.

We must also emphasize that Appellants' Specification expressly states that “[t]he present invention can be realized in hardware, software, or a combination of hardware and software.” (Spec., § [0024].) Thus, Appellants' invention is broad enough to include only software. For example, the claimed “topic thread”, “data aggregator” and “computing platform” all can be software/program components. A claim that recites no more than software, logic, or a data structure (i.e., an abstraction) does not fall within any statutory category. *In re Warmerdam*, 33 F.3d 1354, 1361

(Fed. Cir. 1994). Significantly, “[a]bstract software code is an idea without physical embodiment.” *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 449 (2007). The unpatentability of abstract ideas was recently reaffirmed by the U.S. Supreme Court in *Bilski v. Kappos*, 130 S.Ct. 3218, 3222 (2010).

Independent claim 9 recites, *inter alia*, a “machine readable storage having stored thereon a computer program . . .when executed by a machine causes the machine . . .” In construing claim 9 in its entirety, we find that the claim is more than program instructions as the Examiner appears to contend. *See in re Geerdes*, 491 F.2d 1260, 1262-63 (CCPA 1974) (stating that “every limitation in the claim must be given effect rather than considering one in isolation from the others”); *see also Diamond v. Diehr*, 450 U.S. 175, 188 (1981) (noting that claims must be considered as a whole to determine eligibility under § 101). The recited “machine readable storage” is thus more than descriptive material per se (e.g., instructions) or an abstract idea. *See Warmerdam*, 33 F.3d at 1360-61. The Specification describes the computer program product as being loaded into a computer system to enable it to carry out the methods (Spec., 10-11, ¶ [0025]).

Although a computer-readable medium can constitute non-statutory subject matter under certain circumstances, that is not the case here. *See Ex parte Gutta*, 93 USPQ 1025, 1033-34 (BPAI 2009) (precedential) (concluding that a claim directed to a computer-readable medium with mathematical algorithm code embodied thereon was non-statutory since the claim (1) failed to recite a tangible practical application resulting in a real-world use, and (2) encompass substantially all practical applications of the mathematical algorithm in substantially all fields of use).

Furthermore, the Examiner has not shown, and we do not readily find, any expressed embodiments of the claimed medium that would be broad enough to implicate the readable storage as encompassing carrier waves or signals. Thus, claim 9 is not directed to a transitory media which is a non-statutory signal under § 101. *See Nuijten*, 500 F.3d at 1357; *see also* David J. Kappos, *Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (fed. 23, 2010). Therefore, we reverse the rejection of claim 9, and associated dependent claims 10-12, as being non-statutory.

Based on the record before us, we find that the Examiner did *not* err in rejecting independent claims 1, 5, and 13 under 35 U.S.C. § 101. However, we find that the Examiner did err in rejection independent claim 9 under 35 U.S.C. § 101.

Accordingly, (1) we affirm the rejection of claims 1, 5, and 13, as well as associated dependent claims 2, 4, and 6-8 under 35 U.S.C. § 101, and (2) we reverse the rejection of claim 9, as well as associated dependent claims 10-12 under 35 U.S.C. § 101.

§102(b) Rejection

Claims 1, 2, and 4-13

Appellants argue claims 1, 2, and 4-13 as a group (App. Br. 8-9). For claims 2 and 4-12, Appellants in essence repeat the same argument made for claim 1. We will, therefore, treat claims 2 and 4-13 as standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

Issue3: Did the Examiner err in finding that Fredell discloses externally sourced content postings from another discussion forum resource?

Appellants contend that “[n]owhere in Fredell is there a teaching directed to externally sourced content compris[ing] postings from another discussion forum resource as expressly required by claim 1.” (App. Br. 8.)

The Examiner found that “[A]ppellant uses the terms *discussion forum resource* (and not a discussion forum), therefore Fredell, discloses this limitation through[] FIG. 4.” (Ans. 11.)

In essence, the Examiner is limiting Appellants’ claims to a “data resource” and not a “discussion forum.” We disagree with this construction.

For instance, although Appellants use the term “*discussion forum resource*,” we find that Appellants’ Specification shows that the usage of the term is consistent with describing a discussion forum.

During examination, claims are to be given their broadest reasonable interpretation consistent with the specification, and the language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Amer. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (citations omitted). The Office must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. *Id.* (citations omitted).

Here, in light of the Specification (*see* para. [0007]), we find that the broadest reasonable interpretation of the claimed “*discussion forum resource*” is consistent with the term of art *discussion forum* itself which includes discussion type responsive postings. Thus, we find that the Examiner has improperly construed the claims.

Fredell discloses “posting over the global communications network.” (FFs 1-3.) While Fredell’s posting include a listing of project tasks and the status thereof (FF 1), Fredell postings also includes a discussion forum for issues that may develop during the project (FFs 2-3). However, the Examiner has not shown, and we do not readily find, where Fredell discloses that postings to the discussion forum are externally sourced from another discussion forum, as required in claim 1.

In addition, we find that the Examiner has not shown “creating a new topic thread for said externally sourced data,” as set forth in claim 5. The Examiner merely relies upon Fredell’s clickable icons and hyperlinks to document resources (Ans. 11-12). However, regarding Fredell’s discussion forum (FF 3), the Examiner has not shown how a new topic thread is created for any externally sourced data.

Similarly for claim 13, the Examiner again relies upon the flawed claim construction noted *supra* in finding that Fredell discloses synchronizing postings in two discussion forums. As noted above, the present invention includes a “discussion forum” and not merely discussion resources, as argued by the Examiner. For at least this reason, we find that the Examiner has not shown that Fredell discloses synchronizing postings as claimed in claim 13.

Therefore, based on the record before us, we find that the Examiner did err in rejecting claims 1, 2, and 4-13. Accordingly, we reverse the rejection of claims 1, 2, and 4-13 under 35 U.S.C. § 102(b).

DECISION

We reverse the Examiner’s § 112, first paragraph rejection;

We affirm the Examiner's § 101 rejection of claims 1, 2, 4-8, and 13;

We reverse the Examiner's § 101 rejection of claims 9-12; and

We reverse the Examiner's § 102 rejection of claims 1, 2, and 4-13 over Fredell.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2009).

AFFIRMED-IN-PART

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